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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,704	02/14/2005	Rowena V. Cube	MS022YP	1366
210 7590 03/28/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER SHIAO, REI TSANG				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
03/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/524,704

**Applicant(s)**

CUBE ET AL.

**Examiner**

REI-TSANG SHIAO

**Art Unit**

1626

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED on 02/29/2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 29 and 31.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: see below.

/REI-TSANG SHIAO /  
Primary Examiner, Art Unit 1626  
03/21/2008

1. Amendment including cancellation of claims 1-28 and 30 in the amendment filed on 02/28/2008 is acknowledged. Claims 29 and 31 are pending in the application.

#### Responses to Amendment/Arguments

2. Applicant's arguments regarding the rejection of claims 29 and 31 under 35 U.S.C. 103(a) filed on February 28, 2008 have been fully considered and they are persuasive, in part. Applicants claim compounds/compositions of claims 29 and 31, i.e., formula (I), wherein the variable W represents tetrazolyl, the variable X or Y is O, the variable m is 0, the variable R2 or R3 independently represents hydrogen, hydroxyl, halogen, or alkyl, the variable R1 represents cycloalkyl, phenyl, or alkyl, and the variable n is 4.

Goldworthy et al. US 4,595,540 disclose compounds/composition of the formula, wherein the variable Z is 5-(1H-tetrazole), X or Y is O or S; the variable n is 2-6, R1, R2 independently represents hydrogen or alkyl, see columns 1-2.

The difference between the instant claims and Goldworthy et al. is that the variables R1 and R2 of Goldworthy et al. independently represents alkyl, while the instant claims represent alkyl, cycloalkyl or phenyl at the same position. Therefore the compounds No. 4-6, 10, 13, 15, 17-19, 21-24 and 27 of claim 29 still render obviousness over Goldworthy et al.'540. Deletion of the obviousness compounds of claims 29 and 31 would obviate the rejection. It is noted that the invention of claims 29 and 31 are commensurate within the scope of the invention of compounds of formula (I) of claim 1, which has been rejected on the record under 35 U.S.C. 103(a) over Goldworthy et al. US 4,595,540, see the paragraph 9 of the non-final rejection of the Office action dated 06/21/2007. Since claims 1-28 and 30 have been cancelled, the rejection of claims 1-28 and 30 under 35 U.S.C. 103(a) has been obviated herein.

3. The invention of the compounds/composition claims 29 and 31 are distinct from Doebber et al. US 6,020,382 or Belanger et al. US 4,820,867, wherein Doebber et al. '382 or Belanger et al. '867 claim distinct invention. A rejection under the obviousness- type double patenting over Doebber et al. '382 or Belanger et al. '867 can not be applied. Since claims 1-28 and 30 have been cancelled, the rejection of claims 1-28 and 30 under the obviousness- type double patenting has been obviated herein.

4. Claim 29 is objected to as containing a typograph error. Incorporation of a term "and" after the second last compound would obviate the objection.